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APPLICATION NO. 247	FILING DATE 07/18/96	FIRST NAMED INVENTOR KIM	ATTORNEY DOCKET NO. S 678-10
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EXAMINER FERGUSON, K	
ART UNIT 2608	PAPER NUMBER

DATE MAILED: 05/13/97

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

08/683,240

Applicant(s)

Kim et al.

Examiner

Keith Ferguson

Group Art Unit

2608



☒ Responsive to communication(s) filed on Feb 18, 1997

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-13 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-13 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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Claim Rejections - 35 USC § 112

1. Claims 1, 3, and 8 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The phrase "an elongated" reception guide rail was not recited in the original disclosure.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. § 103, the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 C.F.R. § 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of potential 35 U.S.C. § 102(f) or (g) prior art under 35 U.S.C. § 103.

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3. Claims 1-13 are rejected under 35 U.S.C. § 103 as being unpatentable over Takagi et al. (U.S. Patent 5,257,310 herein after "310 ") and Takagi et al. (U.S. Patent 5,335,273 herein after "273).

Regarding claims 1,3 and 7-10, "310 discloses a portable telephone (button cover holding mechanism) comprising a cover (button cover) with a plurality of circular holes therein (Fig. 3 numbers 14 and 29), an upper case (body) aligned with holes (reception guide rails) and a cover mounting projection (projection bar) (Fig. 3 numbers 2a, 20 and 18). A pipe shaft (cylindrical bush) and a circular hole (cylindrical ring) inserted in the circular holes of the cover (Fig. 7 and 8 numbers 30 and 20). The cylinder bush and the cylinder ring are outwardly positioned by a restoring force of the spring to fit the cylinder ring in the reception guide rail (Fig. 7 numbers 20 and 38), the body having an elongated reception guide rail form (Fig. 3 numbers 20), the circular hole is inserted into the hole of the upper case by positioning the pipe shaft toward the cover mounting projection of the upper casing (Fig. 7), a trough portion of the pipe shaft is assembled to contact the cover mounting projection (Fig. 9 and column 5 lines 1-40), the pipe shaft includes a wave cam (wave projection) (Figs. 7 and 9 number 40), the cover mounting projection of the upper case is in contact with the wave cam to apply biasing force (restoring force) on the spring to the pipe shaft (Fig. 7 number 38 and column 5 lines 4-16), the biasing force is generated by a change in a moving distance of the spring according to the phase of the pipe shaft which causes a moment for rotation the cover, for facilitating opening and closing the cover (Fig. 8 and 9 and column 5 lines 30-50). A

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telephone (telephone circuitry) comprising a switch section (plurality of buttons)(Fig. 1 numbers 2 and 8) and a cylindrical member (cylindrical ring) inserted into the circular holes of the button cover (Fig. 7 number 32). "310 differs from claim 1 of the present invention in that it fails to recite that the spring is inserted into the circular holes of the button cover. "273 discloses a portable telephone and multifunctional protective housing comprising a spring inserted in the circular holes of the body cover (Fig. 12 numbers 40 and 50). The large diameter portion (cylindrical bush) and spring are outwardly positioned by restoring force of the spring (Fig. 12 and 13 numbers 46 and 50). Therefore, having the cited art of "273 at the time the invention was made it would have been obvious to one of ordinary skill in the art to mount the cylindrical ring and spring in the circular holes as taught by "273 to open and close the button cover. The patents of "310 and "273 do not recite that they are sealed bic connection technique. Applicant should note that the patentability of a product does not depend on its my an ultrasonethod of production. If the product in the product-by-process claim is the same or obvious from a product of prior art, the claim is unpatentable even though the prior product was made by a different process. In re Thorpe, 227 USPQ 964, 966 (Fed. Cir. 1985). See MPEP 2113.

Regarding claim 2, "310 discloses the incline middle portion of the pipe shaft is in contact with the cover mounting projection of the upper case when the cover is in the close position (Fig. 6a), and the trough portion of the pipe shaft is in contact with the cover

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mounting projection when the cover is in the open position at a predetermine angle (Fig. 6b and column 5 lines 25-35).

Regarding claims 4 and 13, "310 discloses the resilient member is a spring which generates a biasing force by a change in a moving distance of the spring for rotating the cover for facilitating opening and closing the cover (Fig. 8 and 9 and column 5 lines 4-39).

Regarding claim 5, "310 discloses the pipe shaft includes a wave cam (wave projection) (Figs. 7 and 9 number 40).

Regarding claims 6 and 11, "310 discloses a pipe shaft (cylindrical bush) and a circular hole (cylindrical ring) that are outwardly positioned by the biasing force of the spring (Fig. 7), and the trough portion of the pipe shaft is in contact with the cover mounting projection (Fig. 3 and 7).

Regarding claim 12, "310 discloses the trough portion of the pipe shaft is in contact with the cover mounting projection (Fig. 3 and 7), and positioning the projection cover mount of the upper case to be in contact with the wave cam of the pipe shaft to directly apply a biasing force (restoring force) of the spring to the pipe shaft (Fig. 7 numbers 30,18, 40 and 38).

Response to Amendment

4. Applicant's arguments filed 2/18/97 have been fully considered but they are not deemed to be persuasive. The following are explanations to the applicant arguments:

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5. Argument: Applicant alleges that Takagi et al. (U.S. Patent 5,257,310 herein after "310) and Takagi et al. (U.S. Patent 5,335,273 herein after "273) do not disclose or suggest means for subject matter in amended claims 1,3 and 8.

Explanation: Examiner respectfully disagrees, applicant amended claims 1,3, and 8 using new matter such as "elongated reception guide rails". No where in the original disclosure does it say elongated reception guide rails. '310 teaches holes as reception guide rails, the (length or elongated) of the holes are undefined. (See claims 1,3, and 8)

6. Argument: Applicant alleges that '310 patent does not disclose or suggest a cylinder bush includes wave projections, with a projection bar of the body in contact with the wave projections to directly apply restoring force of the spring to the cylinder bush.

Explanation: Examiner respectfully disagrees, '310 discloses a shaft (cylinder bush) includes angular plate portions (wave projections) with a projection bar of the body in contact with the wave projections to directly apply restoring force of the spring to the shaft (Fig. 4 numbers 24,24c,18,26 and 4 and column 4).

7. Argument: Applicant alleges that '310 requires an extra component, i.e. the spring member 38, independent of spring member 32, independent of spring 34, which spans the cover 2 and engages the wave cam 40 to provide a restoring force to cam 40, as opposed to the implementation of restoring force by the projection bar engaging the cylinder bush, as claimed in claim 1.

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Explanation: Examiner respectfully disagrees, applicant is mislead because nowhere in '310 is there a spring member 32 or spring 34. '310 teaches a spring member (38), a cylinder member (32), and a wave cam (40). The restoring force by the cylinder member engages the cylinder bush (Fig. 7 numbers 32,40,38 and 30).

8. Argument: Applicant alleges that '310 do not contribute to the restoring forced used in opening and closing the cover.

Explanation: Examiner respectfully disagrees because '310 teaches a spring (38) used in restoring force in opening and closing the cover (Fig. 7).

9. Argument: Applicant alleges that '273 patent does not cure the deficiencies of the '310 patent since the '273 also requires assembly of the hinge mechanism by a force fit of circular components into circular cavities, as opposed to using an elongated reception guide rail for facilitating assembly of the hinge mechanism, as in the subject matter of claims 1,3, and 8,

Explanation: Examiner respectfully disagrees, because "273 discloses a portable telephone and multifunctional protective housing comprising a spring inserted in the circular holes of the body cover (Fig. 12 numbers 40 and 50). The large diameter portion (cylindrical bush) and spring are outwardly positioned by restoring force of the spring (Fig. 12 and 13 numbers 46 and 50).

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10. Applicant's arguments filed 2/18/97 have been fully considered but they are not deemed to be persuasive.

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a).


A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

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12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Keith Ferguson whose telephone number is (703) 305-4888.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703)305-3900.

Keith Ferguson, Examiner *KF*
Art Group 2608
April 30, 1997


DWAYNE BOST
SUPERVISORY PATENT EXAMINER
GROUP 2600

*** NOTICE ***

ANY AMENDMENT OR REQUEST FOR RECONSIDERATION IN RESPONSE
TO THIS FINAL OFFICE ACTION SHOULD BE DIRECTED TO:

Commissioner of Patents and Trademarks
